

91 said slots extending from the outer periphery of the respective discs and narrowing toward the center of the respective discs.--

REMARKS

Claim 17 has been amended. Claims 13-14 stand withdrawn from consideration.

The numbered paragraphs below respond to the similarly numbered paragraphs in the Official Action of September 30, 1999.

1.-2. No response needed.

3. Claim 17 was rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The rejection went on to mention particular portions of the claim alleged to be vague and indefinite, and to make suggestions as to how the claim could be amended. Applicant wishes to thank the Examiner for his helpful suggestions for amending the claim. Claim 17 has now been amended to overcome the rejection under Section 112, second paragraph. It is urged that the rejection is overcome and should be withdrawn.

4.-6. Claim 17 was rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Pelosi, Jr. et al. (U.S. Pat. No. 5,562,006).

The rejection went on:

"Pelosi, Jr. et al. discloses a hand tool with every structural limitation of the claimed invention including a disc (e.g., 12) having opposing cutting edges in the form of a fixed slot (e.g., 18) which slot narrows toward the center of the disc, and having a handle (e.g., 16).

"In the alternative, if it is argued that two of the tools are not disclosed, the Examiner takes Official notice that it is old and well known in the art to provide as many tools as necessary to perform a desired task or tasks. For example, it would have been obvious

to one having ordinary skill in the art to provide two of Pelosi, Jr.'s tools for various reasons including (1) having a second one as backup in case a first one breaks or is lost, or (2) having a second one to provide to other users for performing other tasks. It is noted that the recitations directed to how the tools are used together (e.g., 'said sides directly touching each other at said edges') has been given little patentable weight since it is clearly an intended use of the disclosed tools."

The rejection is respectfully traversed.

First, it is noted that the instant application is a CIP of parent Ser. No. 08/508,255, filed July 27, 1995, and claims the benefit of Swiss priority application no. 02 457/94-2, filed August 8, 1994. The Swiss priority application filing date pre-dates the filing date of the '006 patent to Pelosi, of October 31, 1994. Furthermore, the '006 patent issued on October 8, 1996, which is after the filing date of the instant application.

The '006 patent, therefore, is not a reference under Section 102(b), nor is it prior art at all, in view of the instant application's August 8, 1994 Swiss priority date.

Second, even if, for the sake of argument, the '006 patent were prior art, claim 17 clearly distinguishes over the patent.

The '006 patent does not disclose or suggest several features of pending claim 17. For example, the '006 patent does not disclose or suggest first and second discs having cutting edges formed by a slot of fixed dimensions. The '006 patent is directed to a manual wrench having a plate-like element which has a plurality of substantially equally spaced projections extending around the periphery of the plate-like member. In Pelosi, a slot is formed between two of the projections.

Nor does the '006 patent disclose or suggest two discs directly touching each other at cutting edges.

Nor does the '006 patent disclose or suggest that the slots should narrow toward the center of the discs. Rather, the '006 patent states that "slot 18 has substantially parallel side walls." (col. 2, lines 54-55). It also states that the "slot is, therefore, preferably an elongated U-

shape having a length of about 2.5 inches and in the preferred embodiment a width of 3/8 inches." (col. 2, lines 61-63).

It is urged that a wrench, such as is disclosed in the '006 patent, is a device for gripping and cannot, therefore, have slots such as those called for in pending claim 17 ("extending from the outer periphery ... and narrowing toward the center ..."). Such slots would not be useful in a wrench, nor is the slot disclosed in the '006 patent useful in applicant's device. Furthermore, a wrench such as that disclosed in the '006 patent does not have cutting edges, as are called for in present claim 17, so that even were two of the '006 patent devices used simultaneously, they could not be used to apply a torsional shearing force on the workpiece.

The invention claimed in the pending claim would not be anticipated under Section 102(b) and would not have been obvious to one of ordinary skill in the art at the time the present invention was made over the '006 patent, even if that patent were, in fact, prior art, which it is not as explained above. Nor does the '006 patent provide any motivation to change the device there disclosed to arrive at the applicant's claimed device.

CONCLUSION

All rejections having now been overcome, issuance of a Notice of Allowance is proper and is urged.

Filed herewith is a check in payment of the Petition for Automatic Extension with the required fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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